



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2018-0031]

RIN 0651-AD31

Setting and Adjusting Patent Fees During Fiscal Year 2020

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Final rule; delay of effective date and final rule.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) published a final rule in the Federal Register on August 3, 2020, that includes a fee for patent applications that are not filed in the DOCX format, except for design, plant, or provisional applications. The effective date of this new fee was most recently delayed in a final rule published in the Federal Register on December 29, 2022 and was scheduled to become effective on April 3, 2023. Through this final rule, the USPTO is delaying the effective date of this fee until June 30, 2023.

DATES: This final rule is effective June 30, 2023. As of [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER], the effective date of amendatory instruction 2.i. (affecting 37 CFR 1.16(u)), published at 85 FR 46932 on August 3, 2020, and delayed at 86 FR 66192, November 22, 2021, and at 87 FR 80073, December 29, 2022, and as further amended at 88 FR 17147, March 22, 2023, is further delayed until June 30, 2023. The change to 37 CFR 1.16(u) in amendatory instruction 2.i., published at 85 FR 46932 on August 3, 2020, is applicable only to nonprovisional utility applications filed under 35 U.S.C. 111 for an original patent on or after June 30, 2023.

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SUPPLEMENTARY INFORMATION: On August 3, 2020, the USPTO published a final rule in the Federal Register that included a new fee set forth in § 1.16(u) with an effective date of January 1, 2022. See *Setting and Adjusting Patent Fees in Fiscal Year 2020*, 85 FR 46932. As specified in §1.16(u), the fee is due for any application filed under 35 U.S.C. 111 for an original patent—except design, plant, or provisional applications—where the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in the DOCX format. Therefore, the fee is due for nonprovisional utility applications filed under 35 U.S.C. 111, including continuing applications, that are not filed in the DOCX format.

The USPTO conducted two pilot programs for filing applications in the DOCX format. The eMod Text Pilot Program was conducted between August 2016 and September 2017. The USPTO then expanded the ability to file patent applications in the DOCX format in EFS-Web to all users in September 2017. In 2018, the USPTO launched the Patent Center and conducted the Patent Center Text Pilot Program from June 2018 through April 2020. All applicants have been able to file applications in the DOCX format in the Patent Center since April 2020. Information about the Patent Center is available at www.uspto.gov/PatentCenter. The USPTO continues to hold many discussions and training sessions with stakeholders to ensure a fair and reasonable transition to the DOCX format.

The USPTO is delaying the effective date of the fee set forth in § 1.16(u) until June 30, 2023. The further delay will give applicants more time to adjust to filing patent applications in the DOCX format.

Applicants are strongly encouraged to begin filing patent applications in the DOCX format before the new effective date of the fee. Applicants are also reminded that

they can file test submissions through the Patent Center training mode to practice filing in DOCX. Applicants who have not yet taken advantage of the DOCX training sessions hosted by the USPTO are strongly encouraged to do so. Information on filing application documents in DOCX and a link to the DOCX training sessions are available at www.uspto.gov/patents/docx.

Rulemaking Requirements

A. Administrative Procedure Act: This final rule revises the effective date of a final rule published on August 3, 2020 implementing a non-DOCX filing surcharge fee, and is a rule of agency practice and procedure pursuant to 5 U.S.C. 553(b)(A). See *JEM Broad. Co. v. F.C.C.*, 22 F.3d 32 (D.C. Cir. 1994) (“[T]he ‘critical feature’ of the procedural exception [in 5 U.S.C. 553(b)(A)] ‘is that it covers agency actions that do not themselves alter the rights or interests of parties, although [they] may alter the manner in which the parties present themselves or their viewpoints to the agency.’” (quoting *Batterton v. Marshall*, 648 F.2d 694, 707 (D.C. Cir. 1980))); see also *Bachow Commc’ns Inc. v. F.C.C.*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims). Prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))).

Moreover, the Director of the USPTO, pursuant to authority at 5 U.S.C. 553(b)(B), finds good cause to adopt the change to the effective date of § 1.16(u) in this final rule without prior notice and an opportunity for public comment, as such procedures

would be impracticable and contrary to the public interest. The change to the effective date will provide the public an opportunity to more fully comprehend the nature of, and prepare to comply with, the DOCX format before the new fee is effective. Delay of this provision to provide prior notice and comment procedures is also impracticable because it would allow § 1.16(u) to go into effect before the public is ready for the DOCX format. The Director finds good cause under 5 U.S.C. 553(d)(3) to waive the 30-day delay in effectiveness of this rule. Immediate implementation of the delay in effective date of the fee is in the public interest because it will provide the public an opportunity to more fully comprehend the nature of, and prepare to comply with, the DOCX format before the new fee in § 16(u) is effective.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)) requires that the USPTO consider the impact of paperwork and other information collection burdens imposed on the public. The USPTO has determined that there are no new requirements for information collection associated with this final rule.

List of Subjects for 37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons stated in the preamble, the Office amends 37 CFR part 1 as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

§ 1.16 [Amended]

2. In § 1.16, amend paragraph (u) introductory text by removing “April 3, 2023” and adding “June 30, 2023” in its place.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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